

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)	
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J. Donald HILL <u>et al.</u>)	Examiner: Pavitra KOTINI
)	
Application Number: 10/715,826)	Group Art Unit: 3731
)	
Filed: November 19, 2003)	Confirmation No: 3645
)	
For: METHODS, SYSTEMS, AND)	
APPARATUS FOR PERFORMING)	
MINIMALLY INVASIVE)	
CORONARY ARTERY BYPASS)	
GRAFT SURGERY)	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In an Office Action mailed July 18, 2006, Applicants are requested to restrict the above-captioned application to one of the following four (4), allegedly patentably distinct groups of claims:

<u>Group:</u>	<u>Description of Invention:</u>
Group I (claims 1-12 and 23-33)	A coupler device for conduits of Class 606, Subclass 153.
Group II (claim 34)	A coupler holder and delivery device of Class 606, Subclass 108
Group III (claims 13-22, 35, and 66)	A method of connecting conduits, a method of delivering a coupler into a blood vessel, and a method of performing vascular surgery of Class 128, Subclass 898.
Group IV (claim 36-65)	A system of performing vascular surgery of Class 600, Subclass 201

In response to the outstanding Office Action, Applicants hereby elect Group I, with traverse with respect to Group II,¹ for prosecution on the merits and request further consideration of this application in view of this election.

According to the MPEP, a restriction between inventions is appropriate only (1) when the inventions are shown to be distinct and (2) when there would be a “serious burden” placed on the examiner to examine more than one invention in the same application. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP 803 (emphasis added).

The Office Action acknowledges that the “[i]nventions [of] Groups I and II are related as subcombinations disclosed as usable together in a single combination.” Office Action, Page 2, Lines 17-18. MPEP 803 provides that “[e]xaminers must provide reasons and/or examples to support conclusions” (Emphasis added.) The Office Action has not given sufficient reasons and/or examples in support of the imposition of this restriction requirement. In particular, according to MPEP § 808.02, “[w]here the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c)-§ 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus, the examiner must show by appropriate explanation . . . (A) Separate classification thereof: This shows that each invention has attained a recognition in the art as a separate subject for inventive effort, and also a separate field of search.” (Emphasis added.) Nevertheless, “[i]n outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system . . . that may have material pertinent to the subject matter claimed. . . . The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.” MPEP 904.02(a) (emphasis added). Thus, the Office Action must “explain” that the separate classifications result in separate fields of search.

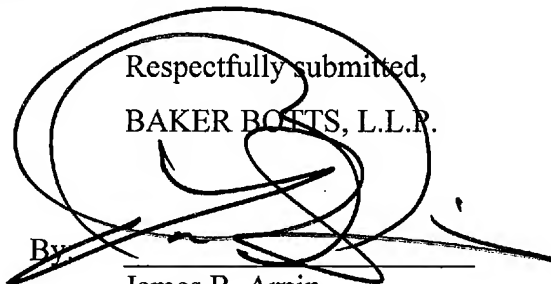
Although the Office Action asserts that **Groups I and II** describe inventions that are in the same class, Class 606, but different subclasses, Subclass 153 and 108, respectively;

¹ Applicants do not traverse the restriction between **Groups I and II**, together, and **Group III** or **Group IV**.

Applicants maintain that the Office Action fails to explain why this separate *subclassification* results in a serious search and examination burden. See MPEP 803. Each of **Group I** and **Group II** relates generally to a coupler. While the Office Action asserts that the subcombinations do not overlap, Applicants maintain that overlap between any search of the coupler (**Group I**) and any search of the coupler holder and delivery device (**Group II**) is "probable." Consequently, the search of either of these groups may uncover art pertinent to the unelected group, and that any additional searching, which may be required to examine both groups together, would not appear to place a "serious burden" upon the Examiner. Moreover, it is common for an examiner's field of search to encompass multiple subclasses. Therefore, although the Office Action demonstrates that **Groups I** and **II** describe distinct inventions, Applicants maintain that the Office Action fails to explain why it would place a serious burden on the Examiner to search and examine both of these groups together. In view of the foregoing remarks, Applicants traverse the restriction requirement with respect to **Groups I** and **II** and respectfully request that the Examiner reconsider and withdraw the restriction between **Groups I** and **II**.

Conclusion:

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicants' representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

Respectfully submitted,
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